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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/719,670	12/14/2000	Andreas Bleckmann	BEIERSDORF 6	2607

7590 03/25/2002

Norris McLaughlin & Marcus P.A.  
30th floor  
220 East 42nd street  
New York, NY 10017

EXAMINER

LOVERING, RICHARD D

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 03/25/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/119,670

Applicant(s)

BLECKMANN ET AL

Examiner

LOVERING

Group Art Unit

1712

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- ☒ Responsive to communication(s) filed on DEC. 14, 2000 AND APR 11, 2001
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-4 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-4 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement

## Application Papers

- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).

☒ All ☐ Some\* ☐ None of the:

☐ Certified copies of the priority documents have been received.

☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_

☒ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

Office Action Summary

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1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 2 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ansmann et al. 5,863,461 in view of Klier et al 5,597,792.

Ansmann et al. (esp.. Examples in col.3) disclose water-in-oil emulsions having 25% various oils (including white oil) including 0.1%-0.5% block copolyesters of PEG 600-300 and ricinoleic acid and having 75% water. While Ansmann et al. do not specifically disclose a low viscosity of at most 5000 mPa's, it would have been obvious to one skilled in the art at the time applicants' invention was made to adjust the viscosity of the water-in-oil emulsions of Ansmann et al. to <20 centistoke (which is <5000m Pa's) which Klier et al. indicate is desirable (col.1, line 38- col. 2, line 61, esp. col. 2, lines 30-40), e.g. by using a higher weight%, e.g. 2% of block copolyesters in the "emulsion concentrates" of Ansmann et al., noting that they contemplate up to 10% thereof (col. 3, Lines 9-12). [It is also noteworthy that Klier et al. (Paragraph bridging col's 6 and 7, esp.. col. 7, line 15) are concerned with water-in-oil emulsions containing glycerol and/or polyglyceryl esters of natural fatty acids as surfactants]. Further, as to claim 2 herein, Ansmann et al. (Col.3, lines 4-12, esp.. Line 8) contemplate, and thus render prima facie obvious, the use of 80% of aqueous phase.

As to claim 14, in Ansmann et al. 5,863,461, the disclosure is directed to a process for the preparation of a water-in-oil emulsion, wherein the oil phase is a mixture of a hydrocarbon oil and a surfactant, and the water phase is a mixture of water and a surfactant, and the process comprises: (a) mixing the oil phase and the water phase; (b) adding a surfactant to the mixture; and (c) stirring the mixture.

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3. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ansmann et al in view of Klier et al as applied to claims 1, 2 and 4 above, and further in view of Diec et al. *mod. by*
- WO98/17238.

While the foregoing combination of Ansmann et al and Klier et al. doesn't disclose the use of PEG-30 dipolyhydroxystearate<sup>a</sup> as a surfactant or emulsifier, it would further have been obvious to one skilled in the art at the time applicants' invention was made to use as a surfactant or emulsifier in the water-in-oil emulsions, modified as above by Klier et al., the PEG-30-dipolyhydroxytearate<sup>s</sup> of Ex. 5 of Diec et al. because the substitution of one old, well-known surfactant or emulsifier of the water-in-oil type for another is not of patentable significance.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1, 2 and 4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by

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"such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claims 1, 2 and 4 recite the broad recitations "1 to 100"; "80% by weight"; "at least 50% by weight" and "polyolefins", and the claim<sup>5</sup> also recites "preferably 2 to 60, in particular 5 to 40"; "in particular 85% by weight"; and "preferably of more than 75% by weight," "and", of the latter preferably: polyd<sup>cen</sup>enes" which is the narrower statement of the range/limitation.

Claims 1 and 4 recite Markush groups which are not considered proper for the reasons that they are indefinite as to scope and incomplete as to their memberships in not reciting-- consisting of-- after "group" (both claims) and in using "and/or" instead of--and-- (only claim 1, line 10).

*NOTE needs to be reported*  
6. Applicants are required to insert the following sentence on page 1 of the specification between the <sup>while</sup> and line 1: <sup>T</sup>his application is a 371 of PCT/EP99/05816 filed June 16, 1999.--

7. The remaining references listed on the attached form PTO-1449 and form-892 are cumulative to the reference applied herein, and/or further show the state of the art.

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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Lovering whose telephone number is (703) 308-0443. The examiner can normally be reached on Mon.-Fri. from 7:30 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Dawson, can be reached on (703) 308-2340. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Examiner Lovering/ng

March 21, 2002

*Richard D. Lovering*  
RICHARD D. LOVERING  
PRIMARY EXAMINER  
GROUP 1200 1700